

REMARKS

Claims 1-25 are pending. Claim 2-7 and 9-23 are withdrawn from consideration. Claims 1 and 8 are amended. The Examiner rejected claims 1, 8, 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,401,999 ("Kephart"). The applicant respectfully traverses the rejections and requests reconsideration in view of the amendments and remarks herein.

I. Interview Summary

The applicant thanks the Examiner for participating in a telephonic interview on November 7, 2006, with the applicant's representative, Fish & Richardson PC, as represented by Brenda M. Leeds Binder. The claims were discussed in view of the Kephart reference. In particular, the meaning of the term "working distance" was discussed. The feature of the microscope claimed wherein both microscopic and macroscopic viewing is provided was discussed. No agreement was reached.

II. The § 103 Rejections

Claim 1 recites a microscope including a base, a support arm, a head, an eyepiece, a stage and an illuminator. The head includes at least a first distal objective lens and a second distal objective lens, where only one of the lens is in optical communication with the eyepiece at a given time. The stage is releasably attached to the support arm and can be attached at multiple locations providing a wide range of working distances between a lower surface of the head and an upper surface of a specimen being viewed with the microscope. By including at least two distal objective lens and a stage releasably attached at multiple locations providing multiple working distances, both microscopic and macroscopic viewing can be provided. As described in the specification at paragraph [0002], microscopic viewing refers to viewing a microscopic specimen, *i.e.*, a specimen that is not visible by the naked eye, at relatively high magnification levels in a relatively small field of view. Macroscopic viewing refers to viewing a macroscopic specimen, *i.e.*, a specimen that is visible by the naked eye, at relatively low magnification levels in a relatively larger field of view.

The applicant respectfully submits the Examiner has failed to establish a *prima facie* case of obviousness, as Kephart does not disclose or suggest all of the limitations of claim 1.

First, Kephart does not disclose a microscope including a stage that is releasably attachable to a support arm to provide a wide range of working distances between a lower surface of the head and an upper surface of a specimen being viewed with the microscope. Kephart discloses a microscope with a "stage adjustable over a wide range of distances relative to the fixed lens" [Col. 1, l. 70]. However, just because Kephart's stage is adjustable over a wide range of distances does not mean that a wide range of working distances are provided. The term "working distance" is a term well known in the art, and is the distance from the lens to the specimen. Claim 1 has been amended to clarify that the term in the claim is used in the same manner as is well known in the art, and as is defined in the specification (see for example, paragraph 0051). Kephart provides a stage adjustable over a wide range of distances so as to accommodate specimens of various sizes and shapes. To use the examples provided in Kephart (Col. 1, ll. 44-46), the specimen size could be relatively small, e.g., a worm, or relatively large, e.g., a sizeable rock. If the specimen is a worm, a relatively thin object, to position the wpr, within a certain working distance from the lens would require the stage at one position. However, if the specimen is a sizeable rock, a much thicker object, to position the rock at the same working distance requires the stage be moved to a much lower position. Accordingly, although a wide range of specimen sizes can be accommodated by having a stage adjustable over a wide range of distances, there may be no range working distances available.

Kephart is silent as working distances, and certainly does not disclose that the Kephart device can accommodate a "wide range of working distances" as is required by claim 1. By contrast, Kephart clearly describes that a limitation with prior art microscopes is that the "range of such size variations is necessarily limited", when referring to the range of specimen sizes accommodated by a typical microscope. Kephart goes on to describe how it is "necessary, therefore, to provide a wider range of adjustment between the stage and the objective than is permitted by the focusing lens itself", to address the problem of limited specimen size. Accordingly, it would seem the entire objective of Kephart's movable stage is to accommodate different specimen sizes, such that whatever the size, the working distance between the specimen and the lens is appropriate; there may be only one available working distance. Kephart does not

discuss the working distance and as mentioned above, certainly does not disclose that a wide range of working distances are available.

Second, the microscope recited in claim 1 provides a stage that is releasably attachable providing a wide range of working distances, such that when the first distal objective lens is in optical communication with the eyepiece, microscopic viewing is provided, and when the second distal objective is in optical communication with the eyepiece, macroscopic viewing is provided. Kephart does not disclose a microscope that provides both microscopic and macroscopic viewing. By contrast, Kephart seems to teach away from this feature, as Kephart clearly states that the microscope disclosed is directed toward use by non-professionals, and children in particular. The purpose of the adjustable stage in Kephart is to accommodate specimens in a wide range of sizes and the examples given are macroscopic examples, *i.e.*, worms to sizable rocks [Col. 1, lines 44-53]. Further, Kephart states that “professional” microscopes are used to “magnify infinitesimally small specimens such as microbes which are confined to a slide” [Col. 1, lines 28-29], by contrast, the object of Kephart’s invention is to provide a “nonprofessional microscope” [Col. 1, lines 50-51].

By way of additional evidence that Kephart’s microscope cannot provide microscopic viewing, there is no illuminator provided between the base and the stage in Kephart. It is well known in the art that illumination is typically required for microscopic specimens, particularly in the magnification range exceeding 45x as set forth in the claim. Because Kephart’s microscope is designed for macroscopic viewing, it makes sense that no illuminator is provided. By contrast, the microscope recited in claim 1 requires an illuminator.

The Examiner states that the title of Kephart’s invention is “microscope” which implies viewing microscopic objects. The applicant respectfully disagrees with this assertion. Merely because the inventor chose to refer to his device as a microscope, which may be considered a misnomer, does not change that there is nothing in the description of the device to suggest that microscopic viewing is possible. By contrast, the description includes a statement that by removing the stage completely, the “lens may be completely unobstructed and thereby aimed at the surface of a tree ... in the manner of a simple hand magnifying glass”, again indicating that the device is designed for macroscopic viewing.

The Examiner states that viewing magnification is determined by the particular objective being used. The Examiner further states that microscope objectives of various magnifications which are useable at working distances in the claimed range are well known in the art (the applicant makes no express admission of such prior art). In any event, what is claimed is the combination. A microscope that includes objectives that can provide both microscopic and macroscopic viewing by providing an adjustable stage that can accommodate the wide range of working distances required for such microscopic and macroscopic viewing is novel and inventive and is not disclosed in Kephart.

Further, the applicant respectfully submits the Examiner has impermissibly used hindsight in an attempt to reconstruct the applicant's invention. It is improper to use the applicant's disclosure as the motivation to combine the particular teachings in the cited references: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure". See, MPEP 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Merely because prior art can be modified is not sufficient to render a claim *prima facie* obvious. See MPEP § 2143.01, which sets forth the applicable standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

As held by the Court of Appeals for the Federal Circuit, in imposing a rejection under 35 U.S.C. §103, the Office Action must make a "thorough and searching" factual inquiry and, based upon that factual inquiry, explain why one having ordinary skill in the art would have been realistically motivated to modify the prior art design to arrive at the claimed invention. See, *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). That burden has not been discharged. There is nothing disclosed in Kephart to suggest a motivation for combining a prior art device with microscopic viewing with Kephart's device, which is clearly directed to macroscopic viewing. By contrast, Kephart clearly identifies the motivation for his design is to accommodate a wide range of sizes of specimens, *e.g.*, from a worm to a sizeable rock to the bark on a tree, an object of the invention of which is conceded by the Examiner. The Examiner states that "one of the objects of Kephart's invention is to enable viewing of specimens within a

wide range of sizes”, with which the applicant would agree. However, the Examiner goes on to state that the object is provided “by making the device adjustable over a wide range of working distances”. The applicant strongly disagrees with this statement. As already discussed, Kephart discloses a stage adjustable over a wide range of distances but does not disclose that the device is adjustable over a wide range of working distances.

The applicant respectfully submits the Examiner has failed to show a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings” [MPEP, §2143]. Second, to establish a case of *prima facie* obviousness, “there must be a reasonable expectation of success”. Third, “the prior art reference (or references when combined) must teach or suggest all the claim limitations” [MPEP, §2143].

As discussed above, there is no suggestion or motivation provided to modify Kephart as suggested by the Examiner. Further, there is no reference that teaches a microscope with a wide range of working distances such that both microscopic and macroscopic viewing as defined are provided. Accordingly, a *prima facie* case of obviousness has not been established and claim 1 is in condition for allowance. Claims 8, 24 and 25 depend from claim 1 and are therefore allowable for at least the same reasons.

Claims 24 and 25 are also allowable for at least the following additional reasons. Claim 24 recites the microscope of claim 1, wherein microscopic viewing is provided at a plurality of magnification levels between approximately 50x and 200x with an approximate working distance of 5 millimeters. Kephart fails to disclose a microscope providing such microscopic viewing, while at the same time being able to provide macroscopic viewing.

Claim 25 recites the microscope of claim 1, wherein macroscopic viewing is provided at a plurality of magnification levels between approximately 5x and 40x with approximate working distances between 70 and 80 millimeters. Again, Kephart fails to disclose a microscope providing such macroscopic viewing, while at the same time being able to provide microscopic viewing. Accordingly, claims 24 and 25 are in condition for allowance.

As a final matter, the applicant would like to make an objection for the record as to a statement included by the Examiner in the office action at page 3, first paragraph. The Examiner

stated that the applicant has not traversed the Examiner's statement in the previous office action of what was well known in the art and therefore took the statement to be admitted. The applicant respectfully objects to the Examiner's assumption that the applicant has made any such admission of prior art. The applicant clearly stated in the first paragraph of the remarks in the Reply filed on April 19, 2006, that the applicant traversed the rejections. Traversing the rejections clearly was not an acceptance of the Examiner's statements and there was no admission of prior art.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

Please apply the Petition for Extension of Time fee for a three-month extension of \$510.00 to deposit account 06-1050. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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